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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,755	08/28/2001	Nikhil M. Deshpande	884.493US1	5778
21186	7590	08/11/2010	EXAMINER	
SCHWEGMAN, LUNDBERG & WOESSNER, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402			CHANKONG, DOHM	
			ART UNIT	PAPER NUMBER
			2452	
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			08/11/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/940,755	DESHPANDE, NIKHIL M.
	<b>Examiner</b>	<b>Art Unit</b>
	DOHM CHANKONG	2452

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02 June 2010.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-25 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

This non-final rejection is in response to Applicant's amendment and arguments filed on 6/2/2010. Applicant amends claims 1, 4-8, 10, 11, 12, 17, and 22-24. Accordingly, Applicant presents claims 1-25 for further examination.

### **I. RESPONSE TO ARGUMENTS**

#### **A. § 101 rejection of claims 22-25**

Under current USPTO policy, the broadest reasonable interpretation of "computer readable storage medium" typically covers forms of non-transitory tangible media and transitory propagating signals *per se*. Applicant may generally overcome this interpretation by clearly defining what is meant by "storage medium" in the specification and/or limiting the claim term to only non-transitory embodiments. However, merely providing examples (e.g., "storage medium may include memory, floppy disks, RAM, ROM...") is not the same as limiting the interpretation to particular embodiments.

Thus, amendment of claims 22-25 to recite "storage media" is insufficient to overcome the § 101 rejection because Applicant's specification does not expressly limit "storage media" to only non-transitory embodiments. Therefore, the claimed "storage media" may still be interpreted as both non-transitory and transitory signals. To overcome this rejection, Applicant should amend the claim to recite "non-transitory storage media."

#### **B. Applicant's arguments with respect to claims 1-25**

Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

## **II. CLAIM REJECTIONS – 35 U.S.C. § 101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

### **A. Claims 22-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claims 22-25 are directed to a storage media. Applicant's specification does not expressly limit "storage media" to only non-transitory embodiments. Therefore, the claimed "storage media" may still be interpreted as both non-transitory media or transitory signals. To overcome this rejection, Applicant should amend the claim to recite "non-transitory storage media."

## **III. CLAIM REJECTIONS – 35 U.S.C. § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

### **A. Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 24 which recites "The storage media of claim [[23]] 22, wherein" is rejected because the claim is missing any limitations.

## **IV. CLAIM REJECTIONS - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**A. Claims 1, 2, 4-15, 17-20, and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Duigou* et al., U.S. Patent No. 7,412,518 [“*Duigou*”], in view of *Carey* et al., U.S. Patent Number 6,714,793 [“*Carey*”].**

In the following mapping, all citations are to *Duigou* unless otherwise noted.

### **Claims, 1, 13, and 19**

*Duigou* as modified by *Carey* discloses a location-based content delivery system and method comprising:

sending a first immediate message [*Carey*, col. 1, lines 60-65: teaching instant messages from a wireless device] from a mobile device at a location [column 7 «lines 4-15»: disclosing a mobile client at a physical location | column 13 «lines 38-62»: disclosing a client that can send messages containing "a string specifying something to locate"]; and

receiving a second immediate message [column 14 «lines 58-60» | column 15 «lines 20-31»: returning the results of the requested search back to the mobile device & *Carey*, col. 1, lines 60-65], wherein the second message comprises a response to the request, wherein the response is dependent on a meaning of the request and the location [column 13 «lines 45-54»: results are returned based on the string identifying something to locate (i.e., meaning) | column 35 «line 57» to column 36 «line 44» | column 85 «lines 6-54»: where results of the search may include "information about restaurants, weather, maps, traffic, movie information, etc., within a certain distance (radius) of the client device" (i.e., location)].

While *Duigou* discloses that the mobile terminal may query a server via a message, *Duigou* does not explicitly disclose that the messages are instant or immediate messages. Nonetheless instant message communication among wireless and non-wireless environments was well known in the art as evidenced by *Carey*.

In similar art, *Carey* discloses a system and method for instant message communication in a wireless and non-wireless environment wherein messages are sent from a mobile unit device over a wireless communication network (col. 1, lines 60-65). Given the teachings of *Carey*, it would have been obvious to a person having ordinary skill in the art to modify *Duigou*'s system to include instant messaging capabilities in order to provide subscribers with the benefits of real-time communication on a constantly open communication channel.

It would be advantageous to communicate via instant text message because text messaging as compared to voice communications is less costly since it utilizes less bandwidth, and is more efficient than playing phone tag or waiting for e-mail replies. See *Carey*, col. 1, lines 47-58. Accordingly, text instant messaging is an efficient cost effective way of communicating. Therefore, the aforementioned limitation would have been an obvious modification to *Duigou*'s system.

### **Claims 2, 15, and 20**

*Duigou* as modified by *Carey* discloses that the first immediate message further comprises sending the first immediate message to a user name identified in a buddy list [*Carey* col. 8, lines 8-18]. See the rejection of claim 1 for reasons to combine *Carey*'s instant messaging functionality into *Duigou*'s mobile proximity discovery services.

### **Claims 4 and 22**

*Duigou* as modified by *Carey* discloses a system and method comprising:  
receiving a first instant message from a sender [column 7 «lines 4-15»: disclosing a mobile client at a physical location | column 13 «lines 38-62»: disclosing a client that can send messages containing "a string specifying something to locate" & *Carey*, column 1 «lines 60-65»: teaching instant messages];  
determining a location of the sender [column 85 «lines 6-54»];  
parsing contents of the first instant message to determine a meaning of the contents [column 13 «lines 45-54»: parsing the string within the request message]; and  
sending a second instant message to the sender [column 14 «lines 58-60» | column 15 «lines 20-31»: returning the results of the requested search back to the mobile device & *Carey*, col. 1, lines 60-65], wherein the contents of the second instant message are dependent on the location of the sender and the meaning of the contents of the first instant message [column 13 «lines 45-54»: results are returned based on the string identifying something to locate (i.e., meaning) | column 35 «line 57» to column 36 «line 44 | column 85 «lines 6-54»: where results of the search may include "information about restaurants, weather, maps, traffic, movie information, etc., within a certain distance (radius) of the client device" (i.e., location)].

See the rejection of claim 1 for reasons to combine *Carey*'s instant messaging functionality into *Duigou*'s mobile proximity discovery services.

### **Claims 5, 11, and 23**

*Duigou* as modified by *Carey* discloses that the method further comprises:  
the contents of the second instant message include information about services,

businesses, hotels, rental car companies, gas stations, restaurants, hospitals or dry cleaners relative to the location of the mobile device [column 85 «lines 13-17»: information about restaurants].

**Claims 6 and 24**

*Duigou* as modified by *Carey* discloses the method further comprising:  
finding information related to the meaning of the contents of the first instant message and the location of the mobile device [column 13 «lines 45-54»: results are returned based on the string identifying something to locate (i.e., meaning) | column 35 «line 57» to column 36 «line 44 | column 85 «line 67» to column 86 «line 39»: location]; and  
building the contents of the second instant message based on the information [column 85 «lines 11-54»: response is based on the user submitted string and location]

**Claim 7**

*Duigou* as modified by *Carey* discloses a server, comprising:  
data indicating a location of a mobile device [column 86 «lines 1-39»]; and  
a personal-assistance controller to parse a request from the mobile device to determine a meaning of the request [column 13 «lines 45-54»: parsing the string within the request message] and to send information to the mobile device [column 85 «lines 11-17»], wherein the information is based on the location of the mobile device and the meaning of the request [column 13 «lines 45-54»: results are returned based on the string identifying something to locate (i.e., meaning) | column 35 «line 57» to column 36 «line 44 | column 85 «line 67» to column 86 «line 39»: location].

**Claims 8, 14, and 16**

*Duigou* as modified by *Carey* discloses wherein the mobile device is connected via a long-lived connection [column 85 «lines 55-65»].

**Claim 9**

*Duigou* as modified by *Carey* discloses wherein the personal-assistance controller is to send an instant message to the mobile device [column 14 «lines 58-60» | column 15 «lines 20-31»: returning the results of the requested search back to the mobile device & *Carey*, col. 1, lines 60-65: sending instant messages], wherein the instant message comprises the information [column 13 «lines 45-54»: sending a message comprising results of the search to the client].

**Claim 10**

*Duigou* as modified by *Carey* discloses a location database comprising the location of the mobile device and the information, wherein the information is specific to the location of the mobile device [column 86 «lines 1-9»].

**Claim 25**

*Duigou* as modified by *Carey* discloses that the location of the sender comprises a location of a hotspot access point [column 87 «lines 19-24»: local distributed computing environment reads on hotspot access point].

**Claims 12 and 17**

The claims contain limitations substantially the same as those previously rejected in claims 1, 4, and 7. Therefore the same grounds of rejection are applicable. Additionally the hotspot access point is functionally equivalent to *Duigou*'s local distributed computing environment].

**Claim 18**

*Duigou* as modified by *Carey* discloses that the personal-assistance controller is to determine the location of the one of the plurality of hotspot- access points via the presence data [column 85 «lines 50-54»: using GPS to determine location of local distributed computing environment].

**B. Claims 3, 16, and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Duigou* and *Carey*, in further view of *Kay* et al., U.S. Patent No. 6,430,602 [“*Kay*”].**

*Duigou* as modified by *Carey* and *Kay* discloses the user name identifies a program executing on an instant-messaging server (i.e., associated entry in the buddy list) [*Kay*, column 2 «lines 33-46» | column 4 «lines 49-57»: disclosing a server program with the screen name ACTIVEBUDDY that responds to user inquiries].

Like *Duigou*, *Kay* is directed to a system for responding to a user’s queries to a server. Further like *Duigou*, *Kay* discloses that a user submits a query to a server, the server reads the meaning of the query, and returns a response to the user based on the meaning of the user’s query [*Kay*, column 3 «lines 6-28»]. However, *Kay* further discloses that the user sends the query to a name on the user’s contact list where the name corresponds to a program that appears as ACTIVEBUDDY on user’s buddy list that is running on the server.

It would have been obvious to one of ordinary skill in the art to have modified *Duigou*’s service discovery system to include the instant messaging program taught in *Kay*. *Kay*’s feature would have improved *Duigou*’s messaging system by allowing users to instant message automated programs in order to access and retrieve data [*Kay*, column 1 «line 63» to column 2 «line 7»].

**V. CONCLUSION**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-3942. The examiner can normally be reached on Monday to Friday [10 am - 6 pm].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thu Nguyen can be reached on (571)272-6967. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DOHM CHANKONG/  
Primary Examiner, Art Unit 2452